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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/789,000	02/26/2004	Thomas M. Mayers	3608	9213
7590 USG Corporation 700 N. Highway 45 Libertyville, IL 60048		10/02/2007		
			EXAMINER CHEVALIER, ALICIA ANN	
			ART UNIT 1772	PAPER NUMBER
			MAIL DATE 10/02/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/789,000
Filing Date: February 26, 2004
Appellant(s): MAYERS ET AL.

**MAILED
OCT 02 2007
GROUP 1700**

Robert Robinson
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 7, 2007 appealing from the Office action mailed July 27, 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner. The 35 U.S.C. §102 rejection of claims 1, 2, 4-7 and 9 over Forry et al. (US Patent No. 4,585,685), made of record in the office action mailed July 27, 2007, pages 2-3, paragraph #4 has been withdrawn due to Appellant's arguments in the appeal brief filed August 7, 2007.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/01396011

BAIG

10-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baig (U.S. Patent Application Publication No. 2002/0139611).

Baig discloses an acoustical ceiling tile (*title*) having a core (*fiber rich surface layer made of mineral wool fibers, paragraph 0021*) made from a starch gel (*starch binder of starch in the form of a gel, paragraph 0027*) and mineral wool fiber (*fiber rich surface layer made of*

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mineral wool fibers, paragraph 0021) composition, wherein the front surface of the tile is coated with aggregate particles (*calcium carbonate particle coating, paragraph 0061*). The aggregate particles are selected from the group consisting of calcium carbonate, crushed marble, sand, clay, perlite, vermiculite, crushed stone and glass and more specifically calcium carbonate (*paragraph 0061*). The building material has a noise reduction coefficient (NRC) value of at least about 0.50 (*paragraph 0062*).

The limitation "abuse-resistant" is a functional limitation and is deemed to be a latent property of the prior art since the prior art is substantially identical in composition and/or structure. MPEP 2145 (II).

The limitation "cast" is a method limitation and does not determine the patentability of the product, unless the process produces unexpected results. The method of forming the product is not germane to the issue of patentability of the product itself, unless Appellant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art. MPEP 2113.

Baig fails to disclose that the particles have an average particle mean diameter of at least about 1,000 microns, more specifically ranging from about 1,400 microns to about 2,500 microns.

However, Baig further discloses that the particles are coarse (*paragraph 0061*).

Therefore, the exact mean diameter of the particles is deemed to be a result effective variable. It would require routine experimentation to determine the optimum value of a result effective variable, such as diameter, in the absence of a showing of criticality in the claimed diameter. *In re Boesch*, 205 USPQ 215 (CCPA 1980), *In re Woodruff*, 16 USPQ2d 1934, 1936

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(Fed. Cir. 1990). Furthermore, it is noted that Appellant defines coarse particles as to have a mean diameter of 2,500 microns (*specification page 9, lines 28-30*).

(10) Response to Argument

2. Appellant's arguments in the Appeal Brief, filed August 7, 2007, regarding the U.S.C. §102 rejection over Forry of record have been considered but are moot since the rejection has been withdrawn.

3. Appellant's arguments in the Appeal Brief, filed August 7, 2007 regarding the U.S.C. §103 rejection over Baig of record have been carefully considered but are deemed unpersuasive.

Appellant argues that Appellant's aggregate particles are embedded in a wet surface and that Baig does not disclose a compression procedure. The limitations on which the Appellant relied (i.e., particles are embedded in the surface and a compression procedure) are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. Furthermore, the method of forming the product is not germane to the issue of patentability of the product itself, unless Applicant presents evidence from which the Examiner could reasonably conclude that the claimed product differs in kind from those of the prior art.

Appellant argues that there is no teaching in the Baig reference relative to abuse/impact resistance. As pointed out in the rejection above, the limitation "abuse/impact-resistant" is a functional limitation and is deemed to be a latent property of the prior art since the prior art is substantially identical in composition and/or structure. Furthermore, Appellant has not specifically pointed out how "abuse/impact resistance" patentably distinguishes the claims from

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the references, nor has Appellant addressed the Examiner's basis for rejection regarding abuse/impact-resistant".

Appellant argues that Appellant's ceiling tile comprises 75-83 weight percent starch gel and only 18-25 weight percent mineral wool fibers, which is not taught by Baig. The limitations on which the Appellant relied (i.e., ceiling tile comprises 75-83 weight percent starch gel and only 18-25 weight percent mineral wool fibers) are not stated in the claims. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable.

(11) Related Proceeding(s) Appendix

For the above reasons, it is believed that the rejections should be sustained.

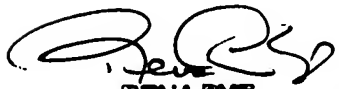
Respectfully submitted,



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